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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/811,910 | 03/30/2004 | Yutaka Takami | 566.35562CX2 | 3171 |
| 20457 | 7590 | 07/28/2004 | EXAMINER | |
| ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889 | | | HESS, DANIEL A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,910

Applicant(s)

TAKAMI ET AL.

Examiner

Daniel A Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17-40 and 43-46 is/are rejected.
7) ☒ Claim(s) 41 and 42 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgement is made of applicant's claim to priority based on continuations extending back to JAPAN 8-187972 filed 07/18/1996.

Remark

Claims 17-30 are only given a double patenting rejection. The examiner wishes to note on the record, however, that it is understood that 'permitting a user to enter instructions to transmit in a lump, all the electronic money stored...' means automatically, i.e. without the user having to specify an amount which happens to correspond with the total amount stored. This, for example, would be possible in Nagata et al., discussed hereinbelow.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,382,505. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences lie in the substitution of the term 'unit' or 'module' for 'button' in various of the independent claims.

The specific claim correspondences are:

Claim 17 of the instance case corresponds to claim 1 of parent Patent No. 6,382,505.

Claim 18 of the instance case corresponds to claim 6 of parent Patent No. 6,382,505.

Claim 19 of the instance case corresponds to claim 2 of parent Patent No. 6,382,505.

Claim 20 of the instance case corresponds to claim 7 of parent Patent No. 6,382,505.

Claim 21 of the instance case corresponds to claim 3 of parent Patent No. 6,382,505.

Claim 22 of the instance case corresponds to claim 8 of parent Patent No. 6,382,505.

Claim 23 of the instance case corresponds to claim 4 of parent Patent No. 6,382,505.

Claim 24 of the instance case corresponds to claim 9 of parent Patent No. 6,382,505.

Claim 25 of the instance case corresponds to claim 10 of parent Patent No. 6,382,505.

Claim 26 of the instance case corresponds to claim 11 of parent Patent No. 6,382,505.

Claim 27 of the instance case corresponds to claim 12 of parent Patent No. 6,382,505.

Claim 28 of the instance case corresponds to claim 5 of parent Patent No. 6,382,505.

Claim 29 of the instance case corresponds to claim 13 of parent Patent No. 6,382,505.

Claim 30 of the instance case corresponds to claim 5 of parent Patent No. 6,382,505.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31-40 and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata et al. (US 4,959,788). Nagata teaches the elements and means recited in claims 31-40 and 44-46. For example, Nagata teaches the following:

Re claim 31: A card is shown in figure 2. An input/output port is shown in figure 2, ref. 1, which acts as a transmission unit and a reading/writing unit, in conjunction with RAM and ROM on the card. An operation control unit is present, namely a CPU (ref. 2 in figure 1) connected RAM, ROM and input/output. See figures 3 and 6: money information is stored in the card in RAM. Study the entire document, but especially column 2, lines 42-46; column 2, lines 52-59; column 7, lines 18-29. As described in column 7, lines 18-29, a user can specify on the card, using the keypad, a “payment amount” (line 25). This payment amount will later be transferred in a single transaction (i.e. in a lump sum) at a later transaction time. The lump sum instruction module and transmission unit in both cases is simply the CPU. Further operation and entry of data again by the user is unnecessary (column 3, lines 10-16) because data has been pre-entered and does not have to be entered at the time of transaction.

Re claim 32: A lump sum drawing instruction module and detection unit are both the CPU of the card. The difference between this claim and claim 31 is that here the user pre-enters

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in to the IC card an amount to withdraw in one transaction, for example from an ATM. This is described in detail in column 7, lines 38-56, as well as throughout the document.

Re claim 33: See discussion re claim 31 above, and note that a 'YES' button (column 15, lines 1-10) is a submit button that essentially confirms lump sum operations (see also figures 19a-19c). Note that although the transaction does not happen immediately but later, nothing in the claim language indicates that the transaction takes place immediately on 'confirming' it.

Re claim 34: See discussion of claim 32 and also of claim 33, regarding 'button.'

Re claims 35/36: See figure 2: ref. 13 is a display.

Re claims 37/38: See figure 2: The keypad 12 allows the user to enter an amount. See also column 7, lines 23-25, 31-33, 46-48 where amount data is entered for different types of transactions.

Re claim 39: See figures 17/18 and column 5, lines 37-43: An ATM is explicitly mentioned.

Re claim 40: See claim 39 discussion, above, and also column 12, line 55. Savings balance is stored on the card. Where else would it come from but the banking machine. Many figures show the card interacting with the ATM machine.

Re claim 43: See discussion re claims 31/33.

Re claim 44: The 'YES' button is employed for the purpose of confirmation of various transactions, a.k.a. lump sum operations.

Re claim 45: See discussion re claims 31 and 33 above.

Re claim 46: See discussion re claim 44 above.

Allowable Subject Matter

Claims 41 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art known to the examiner fails to teach or fairly suggest a card which both pre-entering withdrawal data directly on the card prior to the transactions as per all of the limitations of claim 34 in addition to displaying an on the card amount that has been transferred to the card after the transaction has completed as per all of the limitations of claim 41.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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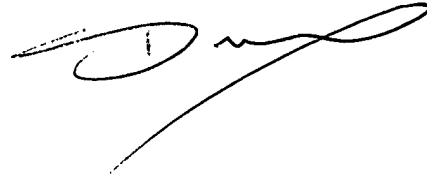
DH

Daniel A Hess

Examiner

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DANIEL STCYR
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'D St Cyr'.